REMARKS

The present Response is intended to be fully responsive to the objections and rejections raised in the outstanding Office Action mailed July 15, 2008 (the "Office Action") and is believed to place the subject application in condition for allowance. Thus, favorable reconsideration of the subject application is respectfully requested.

Applicant notes with appreciation that all previous rejections and objections of Claims 1-21 have been withdrawn in light of amendments and arguments filed on April 15, 2008. The outstanding Office Action, however, advances new art-based rejections under 35 U.S.C. § 103(a) based in part on newly cited US Patent No. 6,219,154 B1, to *Romano et al. ("Romano")*. Pursuant to MPEP § 706.07(a) the Examiner has made this Office Action final. Applicant respectfully requests advisory consideration and review of the foregoing amendments and arguments presented herein.

In the outstanding Office Action, the following issues are raised:

1) Claims 1-4, 6, 9-14 and 21 are rejected as being allegedly obvious under 35 U.S.C. §103(a) over US Patent No. 6,580,524 B1 to *Weichmann et al.* (*Weichmann*) in view of *Romano*.

2) Claims 5 and 15-20 are rejected as being allegedly obvious under 35 U.S.C. §103(a) over *Weichmann* in view of *Romano*, and in further view of US Patent No. 6,429,947 to *Laverty et al. (Laverty)*.

3) Claims 7-8 are rejected as being allegedly obvious under 35 U.S.C. §103(a) over *Weichmann* in view of *Romano*, and in further view of US Patent No. 6,912,071 to *Rasmussen et al. (Rasmussen)*.

As of the mailing of the outstanding Office Action, Claims 1-21 were pending in the application. Applicant notes that, of the pending claims of the application, each of Claims 1 and 21 is presented in independent form. In view of the amendments and arguments advanced herein, Applicant respectfully submits that none of the claims now pending in the application is obvious under the provisions of 35 U.S.C. §103. Thus, Applicant believes that each of the claims now pending in the application is in condition for allowance.

I. CLAIM AMENDMENTS

Applicant has amended each of independent Claims 1 and 21 to clarify and expressly recite that the test image data (representing a test image produced by an image wise colorimetric measurement of at least one edition printing sample) is calculated from the digital printing data. Applicant submits that this amendment is fully supported by the specification, as filed (see, e.g., paragraphs [0046] and [0056]). Applicant further submits that the foregoing amendment is consistent with arguments that were previously presented for the Examiner's consideration. For example, in the previous Response and Amendment dated April 14, 2008 (the "Previous Response"), Applicant argued that "[u]nlike the proposed combination of *Weichmann* and *Hatta*, Applicant's claimed method (i.e., independent Claims 1 and 21) advantageously performs a quality monitoring check using the actual image data for edition printing." The present amendment further clarifies the import of the noted distinction. Accordingly, Applicant respectfully requests prompt entry and substantive consideration of the amended claim language presented herein.

III. REJECTION OF CLAIMS 1-4, 6, 9-14 AND 21 UNDER 35 U.S.C. §103(a)

The Examiner rejected claims 1-4, 6, 9-14 and 21 as being allegedly obvious over *Weichmann* in view of *Romano*. In particular, the Examiner summarized the teachings of *Weichmann*, stating that:

> Regarding [independent] claims 21 and 1, Weichmann discloses a printing process involving two stages, a pre-printing stage and an edition printing stage which comprises in the pre-printing stage producing digital original image data which represent an original master (see FIG. 4 (1,3,70) and Col. 4, Line 17-30);
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> producing the digital printing data from the master image for the printing colors involved in the printing (see Col. 4, Line 17-30);
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> transmitting the digital printing data to a print shop by way of a data channel (see FIG. 4, Col. 8, Line 6-23 and Col. 8, Line 24-33);
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> producing the printing plates in the print shop using the digital printing data for use in the edition printing to be carried out in a printing machine (see Col. 5, Line 54-54);

> using for the color control of the printing machine test data corresponding to the test image produced by an image wise colorimetric measurement of at least one edition printing sample using a spectral color measurement system (see Col. 4, Line 17-30 and Col. 4, Line 43-57);
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> transmitting the results of the quality monitoring from the pre-printing stage to the print shop through a data channel (see Col. 7 Line 6-14, Col. 8, Line 6-23 and Col. 8, Line 24-33); and
>
> using the (sic) in the printing shop the results of the quality monitoring transmitted from the pre-printing stage for at least one of the release of the edition printing and the control of the printing process (see Col. 7 Line 6-14, Col. 8, Line 6-23 and Col. 8, Line 24-33).

The Examiner acknowledges that *Weichmann* fails to disclose [1] "transmitting the test image data produced in the print shop to the pre-printing stage through a data channel" (subsection "b" of claims 1 and 21); [2] "evaluating the test image data in the pre-printing stage for quality monitoring" (subsection "c" of claims 1 and 21); [3] "repeating steps a) to e) if color deviations between the master image data and the test image data are not in acceptable limits" (subsection "f" of claims 1 and 21); and [4] "releasing the edition printing with the printing plates if the color deviations are within acceptable limits" (subsection "g" of claims 1 and 21).

The Examiner, however, takes the position that these steps would have been obvious to a person skilled in the art based on the teachings of *Weichmann* in view of *Romano*. Regarding [1] (transmitting the image data to the pre-printing stage), the Examiner states that "Weichmann teaches communicating processing information and information about the image data to the pre-printing stage (see Fig. 4 and Col. 8, Line 6-23)." Regarding [2] (evaluating the test image data for quality monitoring), the Examiner states that "*Romano* teaches a method for calibrating digital plate setters or image setters (see Fig. 3, Fig. 7A and Col. 2, Line 48-55) in which test image data are used to confirm the acceptability of the image data (see 7A, Fig.8 and Col. 13, Line 10-20)." The Examiner also asserts that "*Weichmann* teaches the use of test forms for quality monitoring and controlling the printing process (see Col. 4 Line 37-57). Regarding [3] (repeating steps a) to e) if color deviations are not in acceptable limits), the Examiner states that "*Romano* further teaches that the quality of the recorded images can be continuously monitored and the plate/image setter can be automatically adjusted to ensure proper recording of the desired image." Finally, Regarding [4] (releasing the

edition printing if the color deviations are within acceptable limits), the Examiner does not cite specific teachings from either *Weichmann* or *Romano*. The Examiner does, however, generally state the "it would have been obvious for one skilled in the art to include...releasing the edition printing with the printing plates if the color deviations are within acceptable limits." The Examiner seeks to combine the teachings of *Weichmann* with the teachings of *Romano* stating that "Weichmann and Romano are combinable because they are from the same field of endeavor, namely print processing systems."

Applicant respectfully submits that the outstanding rejection of the present claims is improper for multiple reasons. As the Examiner is aware, the factual inquiries for establishing a *prima facie* case of obviousness under 35 U.S.C. §103 are set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). These factors include (1) determining the scope and contents of the prior art, (2) ascertaining the differences between the prior art and the claims at issue, (3) resolving the level of ordinary skill in the pertinent art and (4) considering objective evidence present in the application indicating obviousness or nonobviousness. MPEP §2142 states that "the ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence." *See also* In re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992). The Federal Circuit has stated that "rejections on obviousness *cannot be sustained with mere conclusory statements*; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added). MPEP §2142 also states that "[k]nowledge of applicant's disclosure must be put aside in reaching this determination [of obviousness], yet kept in mind in order to determine the "differences"... *impermissible hindsight must be avoided* and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." (emphasis added)

In the current case, Applicant respectfully submits that a *prima facie* case of obviousness has not been established. With regards to the proposed combination of *Weichmann* and *Romano*, Applicant respectfully submits that the Examiner has at least one of: (1) incorrectly determined the scope of the prior art, and/or (2) failed to properly and completely acknowledge the extent of the differences between the prior art and the

claims at issue. More particularly, Applicant submits that *Weichmann* and/or *Romano*, *inter alia*, fail to teach the claimed limitations of producing test image data using "a colorimetric measurement of *at least one edition printing sample*," "evaluating *the test image data* for quality monitoring" and "using...the result of the quality monitoring...to control the print process" (emphasis added). Each of these arguments was advanced in the Previous Response with respect to *Weichmann* and *Hatta*, wherein Applicant maintained that "unlike the *Weichmann* and *Hatta* teachings...Applicant's claimed method includes, *inter alia*, comparing master image data with test image data for purposes of quality monitoring that is used to control the printing process." (Page 11 of the Previous Response)

Applicant notes that, in the context of the present application, "test image data" *is calculated from the digital printing data* (e.g., the digital printing data is used to produce the printing plates which are used to produce at least one edition printing sample which is used to produce the test image data). Thus, as previously argued, "Applicant's claimed method (i.e., independent Claims 1 and 21) advantageously performs a quality monitoring check using *the actual image data for edition printing.*" (Pages 10-11 of the Previous Response) (emphasis added) In the Previous Response, Applicant pointed out that *Hatta* discloses producing test image data for a test pattern, e.g., a color test chart, rather than for an edition printing sample ("according to *Hatta*, the ICC profile is updated using a predetermined master test pattern"). Similarly, *Weichmann* and *Romano* -- alone or in combination -- fail to disclose producing test image data *that is calculated from the digital printing data.*

More particularly and as noted by the Examiner, Weichmann "teaches the use of *test forms* for quality monitoring and controlling the printing process" (emphasis added). Weichmann also teaches the use of a "*color test chart* such as 1 T 8.7/3"" (see Col. 4, Line 44 and 45) Similarly, *Romano* discloses "a digital plate-setter or image setter control wedge formed by recording a *checkerboard pattern*, having a plurality of *checkerboard patches* (Col. 3, Line 25-30), i.e., a test chart. Thus, *Weichmann* and *Romano* use test data derived from *color test charts* to generate a color profile and/or perform calibration. In distinct contrast and as expressly recited in independent claims 1 and 12 (as amended), the subject application calculates test image data from

the digital printing data. Thus, as set forth in the Previous Response, "the quality monitoring check is [advantageously] optimized for the particular edition printing to be performed." Accordingly, Applicant respectfully submits that each of the respective methods of independent claims 1 and 21 patentably distinguishes over the proposed combination of *Weichmann* and *Romano*

Applicant further contends that the Examiner has erred in stating that "it would have been obvious for one skilled in the art to include...releasing the edition printing with the printing plates if the color deviations are within acceptable limits." Applicant respectfully submits that the Examiner has impermissibly presented a "*mere conclusory statement*" unsupported by "some articulated reasoning with some rational underpinning." Moreover, Applicant submits that the Examiner has employed impermissible hindsight, based on the disclosure of the present application, to arrive at a conclusion of obviousness. For example, Applicant submits that it would not have been obvious to a person of reasonable skill in the art to perform quality monitoring wherein an "OK for Edition Printing" may be provided in the pre-printing stage (see Paragraphs 54 and 57 of the subject application). Indeed, printer calibration and quality monitoring techniques, as suggested by the prior art, are *isolated from the edition printing process* (e.g., using test forms/charts). Thus, there is no sound basis for concluding that it would have been obvious to release edition printing while performing said printer calibration and/or quality monitoring based on the teachings of the cited art.

For at least the foregoing reasons, Applicant respectfully submits that each of claims 1 and 21, as amended, are patentable over the proposed combination of *Weichmann* and *Romano*.

Applicant, therefore, respectfully requests reconsideration and withdrawal of the outstanding rejection under Section 103(a) based thereon. Claims 2-4, 6 and 9-14 depend, either directly or indirectly, from Claim 21 and recite additional features therefor. At least since the proposed combination of *Weichmann* and *Romano* does not make obvious Applicant's invention as recited in independent Claim 21, the proposed combination of *Weichmann* and *Romano* also fails to render any of dependent claims 2-4, 6 or 9-14 obvious. Moreover, the Applicant submits that each of the respective methods of dependent claims 2-4, 6 and 9-14 provides patentably distinct results that

are not achieved and/or achievable with any variation of the proposed combination of *Weichmann* and *Romano*. For at least the foregoing reasons, Applicant submits that each of the dependent claims presented herein is patentable over all the art of record, including specifically the proposed combination of *Weichmann* and *Romano*. Accordingly, Applicant respectfully requests withdrawal of the present obviousness rejections of claims 1-4, 6, 9-14 and 21.

IV. REJECTION OF CLAIMS 5 AND 15-19 UNDER 35 U.S.C. §103(a)

As noted above, Claims 5 and 15-19 currently stand rejected for obviousness based on a proposed combination of *Weichmann* in view of *Romano* and in further view of *Laverty*. The rejection is respectfully traversed.

As previously discussed, the factual inquiries for establishing a *prima facie* case of obviousness under 35 U.S.C. §103 include (1) determining the scope and contents of the prior art, (2) ascertaining the differences between the prior art and the claims at issue, (3) resolving the level of ordinary skill in the pertinent art and (4) considering objective evidence present in the application indicating obviousness or nonobviousness. Here, a *prima facie* case of obviousness has not been established, at least because independent Claim 21, from which Claims 5 and 15-19 depend, includes limitations not taught nor suggested in *Weichmann*, *Romano* and/or *Laverty*, whether taken alone or in combination.

In discussing the teachings of *Laverty*, the Examiner focused on the respective limitations of dependent Claims 5 and 15-20. However, as is readily apparent, *Laverty* fails to address and/or cure the deficiencies noted above with respect to independent Claim 21 (from which Claims 5 and 15-20 depend). Applicant respectfully submits that *Laverty* fails to teach or suggest, *inter alia*, a modification to the teachings of *Weichmann* and/or *Romano* that would render obvious independent Claim 21. As such, a *prima facie* case of obviousness has not been established because the combination of the cited references fails to yield a method that includes all of the limitations recited in independent Claim 21. Accordingly, Applicant respectfully submit that Claims 5 and 15-20 patentably distinguish over the proposed combination of *Weichmann, Romano* and *Laverty* for at least the reasons noted herein with respect to independent Claim 21.

Applicant respectfully requests that the present obviousness rejections of Claims 5 and 15-20 be reconsidered and withdrawn, and the claims allowed.

IV. REJECTION OF CLAIMS 7-8 UNDER 35 U.S.C. §103(a)

The Examiner rejected Claims 7-8 as being allegedly obvious over *Weichmann* in view of *Romano* and in further view of *Rasmussen*. The rejection is respectfully traversed.

Claims 7-8 depend, either directly or indirectly, from independent Claim 21 and recite additional features therefor. At least since the subject matter of independent Claim 21 is not obvious in view of the proposed combination of *Weichmann, Romano* and *Rasmussen*, the subject matter of Claims 7-8 is similarly not obvious in view thereof. Accordingly, the Applicant respectfully submits that each of Claims 7-8 is patentable over all the art of record, including specifically the proposed combination of *Weichmann, Romano* and *Rasmussen*. Applicant respectfully requests that the present obviousness rejections of Claims 7-8 be withdrawn, and the claims allowed.

CONCLUSION

For at least the foregoing reasons, the Applicant submits that the Examiner's concerns leading to the present rejections of Claims 1-21 have been fully and completely addressed, and that none of the claims presently in the application are obvious under the provisions of 35 U.S.C. §103. Consequently, the Applicant believes that each of these claims is presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Office believes that any unresolved issues still exist or if, in the opinion of the Office, a telephone conference would expedite passing the present application to issue, the Office is invited to call the undersigned attorney directly at 203-399-5920 or the office of the undersigned attorney at 203-399-5900 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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